

(d) REMARKS

The claims are 1 and 3-9 with claim 1 the sole independent claim. The subject matter of claim 2 has been added to claim 1 and claim 2 has been cancelled. Claims 3, 6 and 8 have been amended as to form only, which changes are unrelated to patentability. Reconsideration of the claims is expressly requested.

The Examiner had objected to the disclosure based on a lack of capitalization of trademarks. The specification has been reviewed and any trademarks identified have been capitalized.

The Examiner had objected to claim 9 as lacking antecedent basis in the specification. In order to resolve this issue, claim 9 has been amended to include the compounds of Formula 13 on pages 38 and 39 of the specification.

Claims 3 and 6-8 were rejected under Rule 112, second paragraph, as being indefinite for the reasons set forth in paragraph 5 of the Official Action. The claims have been amended in accordance with the Examiner's concerns to resolve the issues.

The Examiner has set forth art rejections in paragraphs 9-22 of the Official Action. The Examiner has cited either Kishiki or Shirai as disclosing a polyester toner binder resin obtained by using a titanium chelate compound as a catalyst. Each of the art rejections require at least Kishiki or Shirai to teach the instant polyester toner binder resin to order to raise a prima facie case of obviousness. There is no prima facie case of obviousness without the teachings of Kishiki or Shirai as interpreted by the Examiner.

With regard to the rejections based on Kishiki, WO 03/073171 A1 was filed with the Japanese Patent Office as International Receiving Office on May 28, 2003, and

was published under PCT 21 (2) in the Japanese language on September 4, 2003. Kishiki was published in the United States under 35 U.S.C. 122 (b) on December 2, 2004 having a 371 date of July 13, 2004 for 102(e) purposes. Accordingly, the earliest effective dates of Kishiki are September 4, 2003 and July 13, 2004 for the PCT publication date and U.S. filing date, respectively.

The present application was filed with USPTO on February 26, 2004. The present application claims foreign priorities based on JP2003-203863 and JP2003-401335, which were filed on July 30, 2003 and December 1, 2003, respectively. JP2003-203863 supports the claimed invention of the present application. Applicants have enclosed an English language translation of JP2003-203863 which demonstrates support for the present claimed invention. Accordingly, the instant invention date of July 30, 2003 antedates Kishiki and serves to remove it as a reference. Therefore, Kishiki is not applicable as prior art.

With regard to the art rejections based on Shirai it should be understood that the magnetic toner of the present invention comprises a binder resin which contains a polyester component polymerized by using "a Ti chelate compound having a ligand selected from the group consisting of a diol, a dicarboxylic acid, and an oxycarboxylic acid" (hereinafter, instant Ti chelate compound) as a catalyst.

The magnetic toner of the present invention exhibits excellent developability even in high-temperature and high-humidity environments. In addition, the consumption of the toner in the system is reduced. This is because a compound formed from the instant chelate compound in the binder resin serves as a dispersant for magnetic

iron oxide in the toner binder resin (see page 6, line 25 to page 8, line 11). It is demonstrated in Table 4 (Examples 1 to 7 compared to Comparative Example 1) in the specification that the polyester component polymerized by using the instant Ti chelate compound can provide excellent developability and reduced consumption for a toner. In Comparative Example 1, Binder Resin 5 was used which is made employing as the catalyst, tetramethyltitanate, instead of a titanium chelate.

Shirai '372 discloses a polyester toner binder resin that is obtained by using a "titanium compound" as a catalyst. The "titanium compound" means the compound represented by following Shirai formula (I) or (II).

Formula (I): $\text{Ti (X)}_n \text{(Y)}_m$

wherein X is a substituted amino group, such as bis(triethanolaminate) and tris(triethanolaminate), Y is an alkoxy group, alkenyloxy group or acyloxy group. None of the ligands of compound formula (I) are a diol, a dicarboxylic acid, or an oxycarboxylic acid as required by the present claimed invention.

In Shirai Formula (II): Ti (Z)_4 , Z is an alkoxy group, alkenyloxy group or acyloxy group, such as $\text{C}_{18}\text{H}_{37}\text{O}^-$, $\text{C}_{14}\text{H}_{29}\text{O}^-$, $\text{C}_8\text{H}_{17}\text{O}^-$, and $\text{HOC}_8\text{H}_{16}\text{O}^-$. The compound represented by Formula (II) is not a chelate compound.

The compound represented by the Shirai formula (I) or (II) is different from "the Ti chelate compound" of the present invention. Shirai employs a tetraoctyltitanate catalyst and it also employs, as a comparative catalyst in Tables 3 and 4, a tetrapropyltitanate and a tetrabutyltitanate. The results with the tetrapropyl- or tetrabutyl-titanates are inferior in reaction activity, hydrolytic resistance and durability, as shown in

Tables 3 and 4 and as noted in paragraph [0099]. The tetrapropyltitanate and tetrabutyltitanate are closer to the tetramethyltitanate of instant Comparative Example 1 than the tetraoctyltitanate relied upon by the Examiner. Therefore, the art teaches that such tetraalkyl titanate catalysts are different in kind from the claimed titanium chelates, thus providing different results.

Shirai does not disclose a polyester toner binder resin that is obtained by using “the instant Ti chelate compound” as a catalyst. Therefore, it is not obvious for a person having ordinary skill in this art to employ a binder resin which contains a polyester component polymerized by using “the instant Ti chelate compound” as the binder resin in the magnetic toner disclosed by Tanikawa’ 432.

Moreover, the binder resin which contains polyester component polymerized by using “the instant Ti chelate compound” has an unexpected effect of providing excellent developability to a toner and reducing the toner consumption.

Accordingly, Applicants submit the Examiner has not raised a prima facie case of obviousness. The claims should be allowed and the case should be passed to issue.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100. All correspondence should continue to be directed to our below listed address.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Peter Saxon", written over a horizontal line.

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